

### REMARKS

Claims 1-32 are pending. Claims 5, 15, and 17 are amended herewith. Claims 7 and 28 are cancelled herewith. Thus claims 1-6, 8-27, and 29-32 are under examination. Support for these amendments can be found for example on page 4, lines 3-6, lines 7-9 and lines 28-30. No new matter is added by these amendments. Please consider the following remarks.

The pending claims generally relate to a shoe having a molded rubber outsole and a molded midsole positioned within the outsole, where the midsole is contoured to approximate the shape of the sole of a wearer's foot. The shoe also includes an upper and a foxing. The foxing is fused to the upper and the outsole along an interface by application of a vulcanization process, thus permanently securing together the upper and the outsole.

#### Drawings:

The drawings are objected to under 37 CFR 1.83(a) as failing to show every feature of the invention specified in the claims. It is asserted that the base panel with contours and stroebel stitching must be either shown in the drawings or cancelled from the claims.

Applicants assert that the base panel with contours is shown in both Fig. 1 and Fig. 2. The base panel is depicted as element 139 and was correctly numbered in Fig. 2 as originally filed. In Fig. 1, however, the same element was incorrectly numbered 129. This error has been corrected in the amended Fig. 1 submitted herewith. Both Figs. 1 and 2 clearly depict the element of a base panel with contours and thus Applicants request that this objection be withdrawn.

Applicants assert that a drawing of stroebel stitching is not required under 37 CFR 1.81(a), as Applicants are only required to furnish a drawing where necessary for the understanding of the subject matter sought to be patented. In the Examiner's own words, "it is extremely well known and conventional to use stroebel stitching to secure uppers to soles." Because the feature is so well known and conventional, a drawing of this feature is not necessary for the understanding of the subject matter. Accordingly, Applicants assert that no drawing depicting stroebel stitching is required and request that the corresponding objection be withdrawn.

#### Specification:

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter of a contoured base and stroebel stitching. Applicants disagree.

The contoured base 139 is described on page four of the specification and is depicted both in Fig. 1 and Fig. 2.

Stroebel stitching is recited in the specification, for example on page 2, lines 22-23 and page 4, lines 6-7. As discussed above, stroebel stitching is extremely well known and conventional in the art, and thus a drawing is not necessary to provide understanding of the feature. Accordingly, Applicants assert that both the contoured base and stroebel stitching have adequate antecedent basis in the specification and request that the objection be withdrawn.

35 U.S.C. 112:

Claims 5, 7, 9, 10, 15-17, 28, and 30-32 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

In claim 5, the phrase “configured to adopt the shape” is objected to as confusing, vague, and indefinite. It is asserted that the phrase does not make clear what structural limitations Applicants intend to encompass. In response to this objection, Applicants have amended claim 5 to clarify that the base panel includes a material that adopts the shape of a contoured midsole.

In claims 7 and 28, the repetition of a limitation in the dependent claim that is present in the base claim is objected to. It is asserted that it is not clear what further structural limitations Applicants intend to encompass. Claims 7 and 28 are cancelled herewith, rendering this rejection moot.

In claims 9 and 10 and in claim 30, the phrase “base panel contoured to approximate” is objected to as confusing, vague, and indefinite. It is asserted that no such base panel has been disclosed and it is not clear what structural limitations Applicants intend to encompass. Applicants disagree. Base panel 139 is described in the specification, for example on page 4, lines 7-9 and lines 28-30. The base panel 139 is also depicted in the drawings in both Fig. 1 (which is amended herewith) and Fig. 2. Applicants assert that the text and figures together

clearly define the structural limitations encompassed by the phrase "base panel contoured to approximate." Accordingly, Applicants request that the rejection be withdrawn.

In claim 15, the phrase "comprises uncured rubber" is objected to as rendering the claim vague, indefinite, and inaccurate. It is asserted that the rubber in the finished shoe is in fact cured. Claim 15 has been amended to recite the rubber is uncured prior to the vulcanization process, thus rendering the claim both definite and accurate.

In claim 17, the phrase "said base panel" is objected to for lacking antecedent basis. Claim 17 has been amended to depend from claim 4, which recites an upper having a base panel. 35 U.S.C. 103:

All of the claims are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,932,950 ("Taber") in view of U.S. Patent No. 5,572,805 ("Giese") and U.S. Patent No. 2,481,389 ("Campagna"). Fig. 7 of Taber is cited for teaching a molded rubber outsole, a molded midsole, an upper, a base panel, an insole, and foxing. Giese is then cited to provide teachings such as providing an outsole in the shape of a shell having a rim, placing the midsole within the shell, and contouring the midsole. Finally, Campagna is cited for a teaching of curing uncured rubber to provide a foxing.

When making an obviousness rejection, the Examiner must provide a motivation to combine the references. In providing this motivation, the Examiner must view the references without using the disclosure of the present invention to provide hindsight. Rather, obviousness can only be established by combining or modifying the teaching of the prior art where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. (See M.P.E.P. §2143.01) Motivation cannot come from the invention itself. (See, e.g., Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc., 21 F.3d 1068, 1072 (Fed. Cir. 1993). Nor can *prima facie* obviousness be established by "using hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

The Examiner asserts that it would have been obvious to modify the Taber shoe by (a) providing a contoured midsole and shell shaped outsole as taught by Giese, and then (b) forming a seam between the outsole and upper, and (c) vulcanizing a foxing thereon, as taught by Campagna. The Examiner contends that the artisan would have made this series of modifications “to increase comfort, support, stability, durability, etc.”

The Examiner is improperly using hindsight gleaned from the present invention to arrive at this conclusion. The Examiner has not provided evidence for a motivation to combine or modify the references, in the references themselves. Nothing in the references themselves suggests that the combination proposed by the Examiner would provide increased comfort, support, stability or durability. Moreover, nothing in Taber or the other cited references suggests that such qualities are lacking in the Taber shoe, or that the Taber shoe would be improved in any way by modifying it as proposed.

Instead, the Applicants themselves discovered that the claimed combination of features provides a securely constructed, lightweight shoe that is easily constructed and is shaped to fit the contours of the sole of the wearer's foot. (See Applicants' disclosure, p. 2, lines 8-10.)

Because the Examiner has not provided evidence of a motivation to combine the references, the obviousness rejection is improper. Accordingly, Applicants request that this rejection be withdrawn.

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Applicants believe that no fee is due. In the event that Applicants have reached this conclusion in error, please apply any charges or credits to deposit account 06-1050, referencing attorney docket number 06128-266001.

Respectfully submitted,

Date: \_\_\_\_\_

August 12, 2003

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